

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-6 were pending.

Claims 1-6 are rejected as being unpatentable over Mann (U.S. Des. 351316) in view of U.S. of Caner (U.S. Des. 242106) and in further view of Perlis et al. (U.S. 5803305). To briefly describe each of these references:

U.S. Design Patent No. 242,106 to Caner is directed to a plate. This plate has food compartments that are lower then the plate structure and are connected in a smooth and curved manner.

U.S. Design Patent No. 351,316 to Mann is directed to a plate. This plated is decorative in design and has a shallow area for holding the cup as well as areas for holding food products.

And

U.S. Patent No. 5,803,305 to Perlis et al. is directed to a plate with a cup holder. There is a general food compartment with a separate compartment for the cup. The cup support area is raised above the rest of the plate structure and the cup support must be enclosed.

In spite of the rejection of all 6 claims on these grounds, the only specific rejections that were discuss were for Claims 1 and 2. However, difference exist between the present invention as described in claims 1-6 and these references. For example, Mann does not seem to disclose the specific connection at the center point as disclosed in this claim. The curvature of the pieces seem different then what is disclosed in this invention. There is specific curvature in the cited reference that does not seem to teach the angular requirements of this claim 1. Also, although the examiner states that Brundage does not teach smooth transition between partition and plate support, this seems to go

against the assertion that Brundage teaches "An upwardly curving peripheral rim connection between said plate support surface and said outer flange" in Fig. 3.

Further, none of these references teach a cup holding area where the bottom area is open.

In addition, Claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brundage (U.S. 3955672) in view of Caner (U.S. Des. 242106) and in further view of (U.S. 5803305). Again, the assertion that Brundage does not teach smooth transition between partition and plate support seems to go against the assertion that Brundage teaches "An upwardly curving peripheral rim connection between said plate support surface and said outer flange" in Fig. 3. Further, there is no specific cite to a figure for "A plate support surface having a peripheral edge"

Finally, claims 5 and 6 were rejected under 35 U.S.S. §103(a) as being unpatentable over Brundage in view of Perlis et al. However, neither of these references add to the teaching of a smooth transition between partition and plate support. This seems to go against the assertion that Brundage teaches "An upwardly curving peripheral rim connection between said plate support surface and said outer flange" in Fig. 3.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j). There is no such teaching or suggestion among these references.

In regard to the several rejections of the claims under 35 U.S.C. § 103(a), based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant

or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a cupholding plate having the curvature described between the partitions as in the present invention. Uniroyal, Inc. v. Rudkii-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The

examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,


John D. Gugliotta, P.E., Esq.
Registration No. 36,538

Patent, Copyright & Trademark Law Group, LLC
202 Delaware Building
137 South Main Street
Akron, OH 44308
(330) 253-5678
Facsimile (330) 253-6658